

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS H. ROESSLER, PAUL T. VAN GOMPEL,
DANIEL R. SCHLINZ, MARK G. HEATH
and GEOFFREY W. FROST

Appeal No. 98-2787
Application 08/554,640¹

ON BRIEF

Before ABRAMS, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.

¹ Application for patent filed November 6, 1995.

Appellants' invention relates to an absorbent article, such as a disposable diaper, with asymmetric leg elastics (34, 38) that provide improved fit and leakage protection. As can be seen in Figure 1 of the drawings, the outboard leg elastic members (38) are located laterally outboard of the inboard elastic members (34) to provide a set of elastic members at each side margin of the absorbent article, wherein the elastic members of each said set are arranged in a staggered overlapping relation. As repeatedly pointed out in the specification and as seen in Figure 1 of the drawings, a major portion of a longitudinal end edge (82) of each of the outboard elastic members (38) is configured substantially coterminous with a terminal side edge (74) of each side margin (20) at the intermediate portion (16) of the absorbent article. At page 3, lines 4-11, of the specification it is noted that

"the article of the present invention can be more effectively produced on high speed manufacturing lines and can be readily constructed to provide a desired conformity to the different, natural body lines and shapes which are typically present at the front and back regions of a wearer's body. The article can also exhibit less bunching at its crotch region and can provide reduced bulk in the crotch. When the article is worn the article can also exhibit less sagging at the waistband

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regions, and can provide improved body conformance and fit. As a result, the article can be readily configured to exhibit improved resistance to leakage and to provide improved aesthetics."

Claims 1 and 12 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix 1 of appellants' brief.

The sole prior art reference of record relied upon by the examiner as evidence of obviousness of the claimed subject matter is:

Roessler et al. (Roessler)	5,540,672	Jul. 30, 1996
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Claims 1 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roessler. The examiner's position as stated in the paragraph bridging pages 2 and 3 of the final rejection (Paper No. 7) is that Roessler

"discloses the claimed invention except for the substantially coterminous relationship between the ends of the outboard elastics and the side edges of the articles. It would have been an obvious matter of design choice to have provided such relationship, since applicant has not disclosed that such relationship solves any stated problem or is for any particular purpose and it appears that the invention

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would perform equally well with the positioning of the elastics of Roessler et al."

Rather than further reiterate the examiner's position on the above rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we refer to pages 3 and 4 of the examiner's answer (Paper No. 13) and to pages 8 through 16 of appellants' brief (Paper No. 12) for the full exposition thereof.

OPINION

In reviewing the obviousness issue raised in this appeal, we have carefully considered appellants' specification and claims, the applied references, and the respective viewpoints advanced by appellants and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejection of the appealed claims is not well founded, and that the evidence relied upon by the examiner does not support a conclusion of obviousness with respect to the subject matter of claims 1 through 20 on appeal.

In evaluating the examiner's rejection of claims 1 through 20 under 35 U.S.C. § 103, we observe that the Roessler reference relied upon by the examiner discloses (e.g., in Figs. 1, 4, 7, 9 and 11) an absorbent article (10) which includes inboard (34) and outboard (38) elastic members located in each of the side margin areas (20) of the article, with the elastic members being arranged in a staggered overlapping relation. Like the present invention, the Roessler reference, in the paragraph bridging columns 1 and 2, indicates that the invention therein

"can more closely conform to the different, natural body lines and shapes which are typically present at the front and back regions of a wearer's body. The article can also exhibit less bunching at its crotch region and can provide reduced crotch bulk. When the article is worn, the article can also exhibit less sagging at the waistband regions, and can provide improved body conformance and fit. As a result, the article can exhibit improved resistance to leakage and can provide improved aesthetics."

The only apparent difference between the absorbent article of the Roessler reference and that which is claimed by appellants herein is the requirement in independent claims 1 and 12 on appeal that a major portion of a longitudinal end edge of each of the outboard elastic members (38) be configured

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substantially coterminous with a terminal side edge of each side margin at the intermediate portion (16) of the absorbent article.

The examiner, recognizing this deficiency in the applied reference, has urged that it would have been an obvious matter of design choice to have provided such a relationship in the Roessler reference, since appellants (in their specification) have not disclosed that such relationship solves any stated problem or is for any particular purpose. Based on the record as a whole, we do not agree with the examiner's assertions that the differences between the claimed invention and the absorbent article of the Roessler patent can be considered to be merely matters of "obvious design choice."

While it is true that appellants' specification (page 3) sets forth general advantages of the absorbent article without attributing those advantages to specific structural features of the absorbent article, appellants have now, in their brief (page 14), indicated that the claimed positioning of a major portion of a longitudinal end edge of each of the outboard

elastic members substantially coterminous with a terminal side edge of each side margin of the absorbent article provides the advantages of more effectively 1) holding the terminal edges of the article against the wearer's body and 2) reducing the amount of unsightly or loosely-fitted free edges. In this light, it is clear to us that the limitation at issue cannot be dismissed as merely being a matter of "obvious design choice," based solely on the examiner's bald assertion that such is the case. On the contrary, in a proper obviousness determination, the examiner is required to consider the totality of the record, including all evidence and arguments presented by appellants during the give-and-take of ex parte patent prosecution, and to evaluate even minor changes in terms of the invention as a whole and in the context of whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to have made the changes that would produce appellants' claimed absorbent article. See, for example, In re Chu, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995) and In re Gal, 980 F.2d 717, 719, 25 USPQ2d 1076, 1078 (Fed. Cir. 1992) which notes that a finding of "obvious design choice" is precluded where

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the claimed structure and the function it performs are different from the prior art.

In support of our above determination, we observe that in the present case the examiner has himself expressly noted (answer, page 4) that he

"does not hold that to have provided the claimed structural limitation to the device of Roessler et al. would have been obvious at the time of the Appellants' invention,"

but rather that he maintains that the purportedly "routine changes" between the absorbent article of the Roessler patent and appellants' claimed invention "are insufficient to be patentably distinguishing." Such a position on the examiner's part applies an entirely inappropriate standard for obviousness under 35 U.S.C. § 103.

For the above reasons, the decision of the examiner rejecting claims 1 through 20 under 35 U.S.C. 103 is reversed.

REVERSED

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NEAL E. ABRAMS)	
Administrative Patent Judge)	
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